

REMARKS

Applicants would like to thank Examiner Yuan for indicating that the rejections over U.S. Application Publication No. 2004/0058217 to Ohlsen *et al.*, alone or in combination with other references, have been withdrawn. Applicants acknowledge the status of claim 28 as "withdrawn".

Double Patenting Rejection

The rejection of the claims under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-36 of U.S. Patent No. 6,713,206 to Markoski *et al.* (Markoski) is respectfully traversed. The claims of Markoski are directed to electrochemical cells, to devices and methods relating to electrochemical cells, or to fuel cells without a membrane between the cell electrodes. In contrast, the pending claims are directed to fuel cells, not to electrochemical cells. The pending fuel cell claims include different limitations from the Markoski fuel cell claims.

Claims 1-32 and 36 of Markoski are not identical to any of the pending claims. Markoski claims 1-32 and 36 each recite "electrochemical cell" in the preamble or in the body of the claim. The term "electrochemical cell" is defined in Markoski as "any seat of electromotive force" (col. 5, lines 19-21). Markoski further defines "electrochemical cell" as a generic term that refers to galvanic and electrolytic cells and that includes batteries, photocells, thermopiles, electrostatic generators and solar cells, in addition to fuel cells (col. 5, lines 24-28; col. 10, lines 51-57). Applicants' specification includes a definition of "electrochemical cell" that is the same as that of Markoski (p.9, lines 12-19; p.18, lines 3-8). Thus, the term "fuel cell" recited in the pending claims is a species of the generic term "electrochemical cell" recited in Markoski claims 1-32 and 36.

Claim 33 of Markoski is not identical to any of the pending claims. Markoski claim 33 is directed to a method of generating electricity that includes complementary half cell reactions taking place at first and second electrodes in contact with first and second liquids. Pending claim 23, which depends from claim 2, recites a method in which first and second liquids in a fuel cell include a fuel and an oxidant, respectively. Claim 33 of Markoski does not require that either of the liquids include a fuel.

Claims 34-35 of Markoski are not identical to any of the pending claims. Markoski claim 34 is directed to a fuel cell in which ions travel between electrodes "without traversing a membrane." There is no channel recited in Markoski claim 34. In contrast, the pending claims recite a channel between the first and second electrodes, which is absent from Markoski claim 34. Markoski claim 35 is directed to a fuel cell improvement that includes "replacing the membrane." None of the pending claims recite replacing the membrane in a fuel cell.

The pending claims do not claim the same invention as claims 1-36 of Markoski. In comparing claims in an issued patent and a pending application, if there is an embodiment that falls within the scope of one claim but not the other, then identical subject matter is not defined by both claims, and statutory double patenting does not exist (MPEP 804.II.A.). A battery, photocell or solar cell that meets the conditions of any of Markoski claims 1-32 or 36 would not fall within the scope of the pending claims, since the pending claims each recite only "fuel cell" in the preamble or in the body of the claim. An oxidation-reduction method that meets the conditions of Markoski claim 33 without using a fuel as the reductant would not fall within the scope of pending claim 23. Claims 34 and 35 of Markoski cannot be correlated to any of the pending claims.

The pending claims are not identical to claims 1-36 of Markoski. Accordingly, Markoski claims 1-36 and the pending claims do not claim the same invention, and double patenting cannot exist. Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

All of the grounds raised in the present Office Action for rejecting the application are believed to be overcome or rendered moot based on the remarks above. Thus, it is respectfully submitted that all of the presently presented claims are in form for allowance, and such action is requested. Should the Examiner feel a discussion would expedite the prosecution of this application, the Examiner is kindly invited to contact the undersigned at (312) 876-1400.

Respectfully submitted,

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